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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/128,721	08/04/1998	TODD ROBERT CARROLL	11632N.020880	3309

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424 CHURCH STREET  
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NASHVILLE, TN 37219-2376

EXAMINER
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SINGH, ARTI R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/128,721

Applicant(s)

CARROLL, TODD ROBERT

Examiner

Ms. Arti Singh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 51-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. The Examiner has carefully considered Applicant's amendments and accompanying remarks filed on 01/02/04. Applicant's amendments have been entered, with the status of the claims being; 1-50 all cancelled, and 50-61 pending. All previously made rejections are now withdrawn and new rejections have been set forth below. Applicant's arguments with respect to claims 50-61 have been considered but are moot in view of the new ground(s) of rejection.

### *Specification*

2. The uses of Trademarks/Tradenames have been noted throughout this application. The specific name/mark should be in ALL CAPS, followed by either a trademark or copyright symbol and be accompanied by the generic terminology. Although the use of Trademarks/Tradenames is permissible in patent applications, the proprietary nature of the marks/names should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as a trademark or tradename. To describe physical or other properties of material by mere use of trademark is objectionable since it has tendency to make trademark descriptive of product rather than leaving trademark to serve its traditional purpose, which is to identify product's source of origin.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 50-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are very broadly claimed.

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5. In Claim 51 specifically, and all dependant claims the term "fabric" does not appear to be positively recited. There is no structural or chemical composition stated. For all practical purposes at this time in the prosecution any fabric having any structure or composition reads on this limitation. Additionally, a "chemical barrier fabric" is claimed however, nothing is stated towards the structure or chemistry of the composite as a whole other than that it states multiple layers. Multiple layers of what? Fabric, film or both, and how many of each if that? And as the language is comprising; this could include a plethora of components which encompass "composite." The present language makes it appear as if the fabric is a crucial ingredient when the final composite is produced. Please clarify the claims to recite the same. As stated above the previous Examiner, made several 112-2 indefiniteness rejections which I have withdrawn, however, the claim language still is unclear as presently stated and thus when given its broadest interpretation it appears to be a composite which Applicant is calling a chemical barrier fabric, but as claimed appears to be something that may be joined with a fabric and is only a coating having resultant properties of melt flow rate, stress cracking and is impermeable. It is very confusing, because when relying on the specification for answers to what the composite may actually be made up of it appears that Applicant is desirous of coating a fabric (any fabric, having any structure and composition) with a thermoplastic polyolefin elastomer (in any amount and any percentage of compositional make up) which has the resultant properties of melt flow rate, stress cracking and is impermeable. And when using the term "impermeable" is one describing the composite as a whole to be impermeable or just the fabric layers?
6. Further the term "resin" in the dependant claims lack antecedent basis.
7. In claim 51 is there an unneeded comma in the second sentence after the words multiple layer?

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***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 51-60 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 6162872 issued to Berta.

11. Berta teaches embossed sheets having grain retention and which can be made from a polyolefin composition containing propylene polymer material, a partially crosslinked thermoplastic olefin elastomer composition, and optionally, crystalline polyethylene. These sheets are used to make car parts such as automobile doors and instrument panels (abstract). The reference is replete with examples of the differing compositions of the thermoplastic polyolefin elastomer. With regard to the limitations of thickness of the elastomer, i.e. claims 58 and 59, it should be noted that optimizing the thickness of a composite is a result effective variable. The greater or lesser in this case of the amount of elastomer used directly affects the strength/weakness of the composite as a whole. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used an elastomer coating of 1-10 mils in the invention of Berta, since it has been held that

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discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have optimized the coating weight, motivated by the desire to obtain a composite that was had pliability (flexible) and was foldable instead of being rigid and hard.

Berta discloses what is set forth above, but does not explicitly suggest that the claimed composite to have the properties of melt flow and stress cracking resistance. However, it is reasonable to presume that the said featured properties are inherent to Berta. Support for said presumption is found in the use of like materials that is, the same thermoplastic olefin elastomer coating of the same chemical composition, applied in the same field of endeavor, which would result in having these properties, when tested against the same standards. The burden is shifted to Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 495.

Alternatively, the presently claimed properties of melt flow and stress cracking resistance, would obviously have been present, once the Berta product was provided. *See In re Best*, 195 USPQ 433.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Arti Singh whose telephone number is 571-272-1483. The examiner can normally be reached on M-F 9-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ms. Arti Singh  
Primary Examiner  
Art Unit 1771

ars 10/04/04